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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/661,159	09/12/2003	Jaime Salvador Vargas	ENDOV-001/US	6784

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PATENT DEPT - INTUITIVE SURGICAL OPERATIONS
1266 KIFER RD BLDG 101
SUNNYVALE, CA 94086

EXAMINER

HOEKSTRA, JEFFREY GERBEN

ART UNIT	PAPER NUMBER
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3736

MAIL DATE	DELIVERY MODE
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06/13/2011

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/661,159	VARGAS, JAIME SALVADOR	
	Examiner	Art Unit	
	Jeffrey G. Hoekstra	3736	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 May 2011.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 26-30 and 56-58 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 26-30 and 56-58 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 December 2008 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Notice of Amendment

1. In response to the amendment(s) filed on 05/09/2011, amended claim(s) 26-30 and new claim(s) 56-58 is/are acknowledged. The current objections and/or rejections is/are *withdrawn*. The following new and/or reiterated ground(s) of rejection is/are set forth:

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 26-30 and 56-58 are rejected under 35 U.S.C. 102(e) as being anticipated by Intoccia (US 2003/0229332 A1) especially as broadly as structurally and/or functionally claimed.
4. For claim 26, Intoccia discloses a rigidizable device (as best seen in Figures 3-5) (paragraphs 31-36, 50, and 51), comprising *inter alia*:
- an inner element (32) (as best seen in Figures 3-5) (paragraphs 31-36, 50, and 51) and an outer element (15) (as best seen in Figures 3-5) (paragraphs 31-36, 50, and 51) positioned concentrically around the inner element (as best seen in Figures 3-5)

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(paragraphs 31-36, 50, and 51), wherein the inner and outer elements are flexible (as best seen in Figures 3-5) (paragraphs 31-36, 50, and 51); and

- a plurality of components (31, 38, and 36) (as best seen in Figures 3-5) (paragraphs 31-36, 50, and 51) positioned between the inner and outer elements (as best seen in Figures 3-5) (paragraphs 31-36, 50, and 51), each component being distinct from the inner and outer elements (as best seen in Figures 3-5) (paragraphs 31-36, 50, and 51);
- wherein in a first state the components interfere between the inner and outer elements with a force sufficient to prevent the inner and outer elements from sliding longitudinally relative to one another (as best seen in Figures 3-5) (paragraphs 31-36, 50, and 51), and in a second state the components do not significantly interfere with the inner and outer elements sliding longitudinally relative to one another (as best seen in Figures 3-5) (paragraphs 31-36, 50, and 51).

5. For claim 27, Intoccia discloses a device, wherein the plurality of components comprises an electroactive polymer (the printed electroactive polymer on catheter 36) (as best seen in Figures 3-5) (paragraph 51 and claim 26).

6. For claim 28, Intoccia discloses a device, wherein the plurality of components comprise balloons (31 and 38) (as best seen in Figures 3-5) (paragraphs 31-36, 50, and 51).

7. For claim 29, Intoccia discloses a device, wherein the plurality of components are energized and expanded radially in the first state (as best seen in Figures 3-5) (paragraphs 31-36, 50, and 51).

8. For claim 30, Intoccia discloses a device, wherein the plurality of components are energized and contracted radially in the second state (as best seen in Figures 3-5) (paragraphs 31-36, 50, and 51).
9. For claim 56, Intoccia discloses a device, wherein the device is rigid in the first state (as best seen in Figures 3-5) (paragraphs 31-36, 50, and 51).
10. For claim 57, Intoccia discloses a device, wherein the device is flexible in the second state (as best seen in Figures 3-5) (paragraphs 31-36, 50, and 51).
11. For claim 58, Intoccia discloses a device, wherein the inner element comprises a first tubular element (32) (as best seen in Figures 3-5) (paragraphs 31-36, 50, and 51) and the outer element comprises a second tubular element (15) (as best seen in Figures 3-5) (paragraphs 31-36, 50, and 51) positioned at least in part around the first tubular element (as best seen in Figures 3-5) (paragraphs 31-36, 50, and 51).

Response to Arguments

12. Applicant's arguments filed 05/09/2011 have been fully considered but they are not persuasive. Applicant argues the anticipatory rejection of claim 26 under Intoccia, specifically arguing

- "Applicant disagrees with the Examiner's attempted correlation of the duct 15, which is a part of a patient's body, to the "outer element" recited in claim 26. In particular, Applicant submits that the body duct 15 cannot be properly construed as a part of a "rigidizing mechanism," as the preamble of claim 26 previously recited.

Nevertheless, Applicant has amended the preamble of claim 26 to further clarify the

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statutory class of the claim as relating to an apparatus by reciting "[a] rigidizable device." Accordingly, the body duct 15 itself cannot be properly construed as an outer element of a "rigidizable device," to which claim 26 is directed. While a rigidizable device, as recited in claim 26, may, for example, be inserted into a body lumen, the body lumen itself cannot be considered part of a rigidizable device. and

- "Furthermore, the Intoccia reference itself does not disclose or otherwise suggest that the body duct 15 is part of a device. Rather, the Intoccia reference discloses that a portion of a device 30 is inserted into the duct 15, with at least the balloon 31 being expanded to secure the position of a first catheter 32 within the body lumen."

13. The Examiner respectfully disagrees, maintains the rejection as set forth and cited above, and in response notes the following:

14. The Examiner initially notes that absent any special definition in the instant Specification upon which Applicant does not appear to rely, the claims and terms therein have been treated on the merits consistent with the disclosure under the broadest reasonable interpretation of the limitations therein and using the plain meaning of the terms.

15. Furthermore and in response to applicant's arguments, the Examiner notes the positive recitation of the transitional phrase "comprising" which is well known to be inclusive or open-ended and does not exclude additional, unrecited elements.

16. In response to applicant's arguments, the recitation "rigidizable device" has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the

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purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

17. The Examiner notes Intoccia's duct 15 may be fairly and reasonably considered to be at least "an outer element", especially as broadly as structurally and/or functionally claimed and especially in the absence of any claim language to the contrary or structure precluding such an interpretation.

18. The Examiner notes Intoccia's duct 15 may be also fairly and reasonably considered to be at least part of "a rigidizable device", especially as broadly as structurally and/or functionally claimed, especially in the absence of any claim language to the contrary or structure precluding such an interpretation, and especially with respect to the recitation in the preamble.

19. The Examiner notes that just because and although Intoccia's catheter is inserted into the duct for use therein, this does not necessarily preclude the use of the duct as a cited element of the device under the broadest reasonable interpretation of the scope of the invention, especially as broadly as structurally and/or functionally claimed and especially in the absence of any claim language to the contrary or structure precluding such an interpretation. See above also with respect to the preamble and transitional phrase.

20. The Examiner notes that the anticipatory rejection under the disclosure of Intoccia as set forth and cited above not only expressly anticipates the broad scope of the claimed invention, it may also be fairly and reasonably considered to be at least a structural equivalent and/or inherently anticipatory and/or implicitly anticipatory.

21. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "a rigidizable device may be inserted into a body lumen") are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Conclusion

22. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey G. Hoekstra whose telephone number is (571)272-7232. The examiner can normally be reached on Monday through Friday 8am to 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Max Hindenburg can be reached on (571)272-4726. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jeffrey G. Hoekstra/
Primary Examiner, Art Unit 3736